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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,503	01/25/2002	David C. Issler	10294-607001	4327

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EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/057,503	<b>Applicant(s)</b> ISSLER, DAVID C.	
	<b>Examiner</b> Anthony Stashick	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22,24,25 and 27-31 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-22,24,25 and 27-31 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18-22, 24, 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 contains the phrase “providing a heel region having an inner surface and an outer surface generally parallel with and adapted to be in contact with a walking surface” which renders the claim vague and indefinite. It is not clear whether both the inner and outer surfaces are parallel and adapted to be in contact with a walking surface or just the outer surface has these limitations applied to it.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 18, 28, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Truelsen 5,079,856. Truelsen “856 discloses all the limitations of the claims including the following: an outsole assembly 24 having a heel region with an inner surface (see Figure 3, heel region shown having an inner surface that 23 is placed upon), an outer surface generally parallel with and adapted to be in contact with a walking surface (that portion of 24 that makes contact with the ground, when contacted with the ground, the outer surface will be generally parallel to the inner surface) and an opening 12 extending from the inner surface to the outer surface (see Figure 3); a footbed 23 positioned over an area

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of the inner surface of the heel region (see Figure 3); a plug 2 combined with the footbed (see Figure 3) to provide a single unit and placed in the opening (see Figure 3) for enhancing comfort; the opening is unobstructed in a location at least partially defined by a bottom perimeter of the plug and a distance between the bottom perimeter and the outer surface (see Figure 3, nothing located between the bottom of the plug and the outer surface of 24); the opening is positioned in a heel region of the inner surface of the heel region (see Figure 3, plug located in the heel region); providing a heel region having an inner surface and an outer surface adapted to be in contact with a walking surface (see Figure 3); extending an opening from the inner surface toward the outer surface (see Figure 3); positioning a footbed over an area of the inner surface of the heel region (see positioning of 2 in Figure 3); placing a plug in the opening for enhancing comfort (see plug 2 in Figure 3); removing obstructions from the opening in a location at least partially defined by a bottom perimeter and the outer surface (note the area under 2 in Figure 3).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 19-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Truelsen 5,079,856 as applied above in view of McClelland 5,775,005. Truelsen '856 as applied above discloses all the limitations substantially as claimed except for the hardness characteristics of the outsole and the footbed. McClelland '005 teaches that the footbed of a shoe can be formed of a material having a first hardness that is less than an outsole material having a second hardness (pad 22 is formed of EVA or other flexible resilient materials while outsole body 24 is manufactured from an opaque natural or synthetic resin that is durable and oil resistant) and that the plug can be formed of a material having a first

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hardness characteristic that is less than an outsole material having a second hardness characteristic (see above). The footbed and the plug are formed of a material having substantially the same hardness characteristic (footbed and plug both are formed of resilient material. Further more, McClelland '005 teaches forming the footbed 22 using a material having a first hardness characteristic that is less than an outsole material having a second hardness characteristic (see descriptions of outsole 24 and footbed 22); forming a plug 30 using a material having a first hardness characteristic that is less than an outsole 24 material having a second characteristic (see descriptions of outsole 24 and plug 30); the footbed is formed of a material having a first hardness characteristic that is less than an outsole material having a second hardness characteristic (see descriptions of footbed 22 and outsole. The purpose of these hardness characteristics is to aid in cushioning the impact of the user's foot with the ground while allowing for long wear of the sole. Therefore, it would have been obvious, to one of ordinary skill in that art at the time the invention was made, to make the footbed material of Truelsen '856 out of a material of lesser hardness than the outsole to allow for the outsole to resist wear and tear while allowing the user's foot to be cushioned during impacts of the user's foot with the ground.

7. Claims 5, 6, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Truelsen 5,079,856 as applied above in view of Design Choice. Truelsen '856 as applied above discloses all the limitations substantially as claimed except for the specific hardness of the material used for the outsole, footbed and plug. It appears that it would have been a mere matter of design choice to choose the hardness of the material to be used for the footbed, plug and outsole to meet the desired function of cushioning the user's foot upon impact and durability of the sole. Therefore, it would have been obvious, and well within the skill of one of ordinary skill in the art, at the time the invention was made, to make the footbed, plug and outsole out of a material made of any desired hardness to aid in cushioning the user's foot and preventing wear of the outsole as desired.

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8. Claims 8-14, 16-17, 24-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Truelsen 5,079,856 as applied to claims 1, 18 and 28 as applied above in view of Lober 844,882.

Truelsen '856 discloses all the limitations of the claims except for the plug having a cap section and a pedestal with a lip being formed by the cap, the plug having first and second protrusions with different peripheries with the second protrusion being attached to the first protrusion and having a periphery larger than the periphery of the first protrusion. Lober '882 teaches that a plug depending from the bottom surface of a footbed and fitted within the opening of a sole can have a pedestal b and cap b' with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap preventing accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of Truelsen '856 as applied to claims 1, 18 and 28 above with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening.

With respect to the perimeters of the cap and pedestal, Lober '882 meets these limitations in as much as that which is shown and disclosed by the applicant. With respect to claim 29, Lober '882 teaches that a plug can depend from the bottom surface of a footbed and be fitted within the opening of a sole; the plug can have a pedestal (first protrusion b) and cap (second protrusion b') with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap prevents accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of Truelsen '856, as applied to claim 28 above, with a pedestal, as taught by Lober '882, to aid in holding the plug in the opening and preventing accidental removal of the plug from the opening.

#### ***Response to Arguments***

9. Applicant's arguments filed April 3, 2006 have been fully considered but they are not persuasive. Applicant argues that Truelsen does not disclose both an outer and inner surface that is generally parallel with and adapted to be in contact with a walking surface. This limitation is addressed in the rejections set

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forth above. It is not clear how the inner surface, being on the inner portion of the shoe, can be adapted to be in contact with the walking surface. With respect to the opening being unobstructed, this limitation was addressed in the rejection and can clearly be seen in Figure 3 as noted. It appears applicant is arguing more than that which is claimed. The limitation that the opening be unobstructed while the inner and outer surfaces are parallel with the walking surface does not appear to be presented clearly in the claims. Furthermore, it is not clear at which time in use of the sole that applicant is claiming these limitations, during use, i.e. moving no force applied, or while standing, i.e. force applied to the sole.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the

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requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS